

OCT 12 2006

Serial No. 10/629,466

Attorney Docket No. IN01481KB

Remarks

Claims 21-40 are pending in the present Application. Of these claims, claims 31-40 have been withdrawn from consideration as a result of an earlier restriction requirement. Applicants previously (in response filed January 25, 2006) canceled claims 31-40 as non-elected claims, while at the same time preserving the right to file one or more divisional application on the invention of the cancelled claims, if Applicants choose to do so.

In the present paper, Applicants have amended claims 21-24 (claims 25-30 are dependent on the amended claims) to exclude subject matter outside the scope of the restriction requirement, i.e., subject matter that does not correspond to R¹ and R² being nonheterocyclic, and R³ being an optionally substituted pyrimidine or pyrimidine N-Oxide.

Rejection under 35 U.S.C. §103

The Examiner has again rejected claims 21-30 under 35 U.S.C. 103(a) as being unpatentable over Albert '920 cited above. The Examiner asserts that the priority document GB '876.4, having a priority date of August 9, 2001, generically discloses that R₂ of formula I of GB '876.4 (akin to R³ of the presently claimed compound) of the presently claimed compound can be phenyl or 6-membered heteroaryl which heteroaryl can be selected from a list of many options, including pyridyl, pyrimidyl and pyridazinyl. The Examiner further asserts that in the absence of unexpected results, claims 21-30 are *prima facie* unobvious, as one of ordinary skill in the art would be guided by the example of a six membered ring aromatic group (example 1 on page 5 of GB '876.4), and the explicit disclosure of the optional choices of the other three six membered heteroaryl groups, i.e., pyridyl, pyrimidyl or pyridazinyl to arrive at the presently claimed compounds. Applicants respectfully disagree with the position taken by the Examiner and traverse this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

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Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2142. None of these three criteria has been met in the present rejection.

The scope of compounds of formula I in GB '876.4 is very large. Even though GB '876.4 discloses that R₂ of formula I can be 6-membered heteroaryl or heteroaryl N-oxide, the examples of heteroaryl rings disclosed on page 3 include many different structural types, viz., furyl, thienyl, pyrrolyl, isothiazolyl, imadazolyl, pyrazolyl, isoxazolyl, pyridyl, pyrimidinyl, or pyridazinyl. Benzo-fused bicyclic rings derived from the aforementioned heteroaryl groups are also included within the scope. GB '876.4 does not provide any motivation to one of ordinary skill in the art to choose and select pyrimidinyl over the many different options for the heteroaryl ring. The Examiner is respectfully requested to withdraw the present rejection.


CONCLUSION

Applicants respectfully request prompt reconsideration of present claims 21-30, and an early allowance of the application.

If the Examiner wishes to comment or discuss any aspect of this application or response, applicants' undersigned attorney invites the Examiner to call him at the telephone number provided below.

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